

Appl No. 09/721,894
Amdt. Dated August 15, 2005
Response to Office Action of July 26, 2005

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REMARKS/ARGUMENTS

Claims

The Examiner rejected claims 1 and 5-16 and commented on claim 27. However, claims 1, 5-17, 19, and 21-32 were pending in the application; thus it is unclear what the status is of claims 17, 19, and 21-32. The Applicant respectfully reminds the Examiner of his duty to respond to all pending claims. See MPEP 707.07(i) Each Claim To Be Mentioned in Each Office Action - "In every Office action, each pending claim should be mentioned by number, and its treatment or status given."

By this amendment no claims have been amended, added or cancelled. Therefore claims 1, 5-17, 19, and 21-32 remain pending in the application.

Claim Rejections – 35 USC §103

Claims 1, 5-6, 9-12, and 14 were rejected under 35 USC 103(a) as being unpatentable over Cooperman et al, US 6,665,490 and in view of Wright et al, US 4,864,618. The rejection is respectfully traversed.

Cooperman et al. reference the same Xerox DataGlyphs that were distinguished from the present invention in the response to the previous office action with reference to Dymetman et al. See Cooperman et al. at col. 7, lines 7-8: "The markings can, for example, be Xerox DataGlyphs." Such DataGlyphs are described in the reference titled "Intelligent Paper" by M. Dymetman, and Max Copperman, in Electronic Publishing, Artistic Imaging and Digital Typograh, Proceedings of EP'98, March/April 1998, Springer Verlag LNCS 1375, pp 392-406, hereinafter Dymetman et al.

Dymetman et al. disclose the use of Intelligent Paper defined as "standard sheets of paper entirely covered with printed marks, invisible to the human eye, but visible to [an optical pointer]" (page 393, third paragraph). Each sheet includes a *page-id*. The Intelligent Paper is then bought in bulk by, for example, a publisher, and visible graphic data is then printed over the invisible marks. See page 398, first paragraph: "...the natural tendency of publisher to buy Intelligent Paper sheets in bulk, so that it may be known by the first router that a certain number of consecutive page-ids are 'owned' by a certain publisher." The publisher must then manually associate each *page-id* with whatever graphic content the publisher chooses to print on the page corresponding to each *page-id*. After such manual association occurs, only then is a router able to associate a particular *page-id* with a "URL of the digital page referenced by [the] *page-id*."

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Such Intelligent Paper that requires manual association between a *page-id* and visible graphic data printed on the page is very different from the Netpages disclosed in the present application. Rather than requiring such manual association, the present invention enables an automatic association between coded data including an identity of a page and graphic data printed on the page. Such automatic association is possible because the same printer prints both the coded data and the graphic data. Such an automatic association between the spatial extent of the visible graphic data and the invisible coded data is now explicitly recited in the present claims. See claim 1: "...wherein the visible graphic data and the invisible coded data are printed by the same printer and at the time of printing the computer system associates the type and spatial extent of each tag of the coded data with the spatial extent of at least some of the graphic data."

The Examiner appears to have rejected the above specific limitations of claim 1 by inaccurately and inappropriately paraphrasing the limitations. On page 3 of the present office action the Examiner stated: "... and the computer system associates the location coordinates of each tag with at least some of the graphic data (Cooperman [sic]; col. 7, lines 9-28; col. 8, lines 39-54; each page includes visible data, such as photographic image, text, and many tags, each tag being indicative page identifier and page location data associated with the visible data.") Although such citations to Cooperman may disclose the paraphrased limitation that was fabricated by the Examiner, they clearly do not disclose the actual limitations, reprinted above, that appear in claim 1.

The Applicant thus respectfully reminds the Examiner that all claim limitations must be considered. See MPEP 2143.03: "All Claim Limitations Must Be Taught or Suggested. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)."

Here, for the reasons discussed above with respect to Dymetman et al, Cooperman et al clearly do not disclose or suggest associating *at the time of printing* the type and spatial extent of each tag of coded data with the spatial extent of at least some graphic data. Any association of coded data and graphic data taught by Cooperman et al must occur through a manual process *after* printing. That is clear from Cooperman et al at col. 8, lines 17-19: "Document 508 may be a blank coded substrate, or such a substrate having human-readable information printed thereon." Thus Cooperman et al requires starting with a blank coded substrate and teaches away from the present invention of printing coded data and graphic data together.

Wright et al teach a printer that includes visible ink and invisible ink, and an internal program for printing value indicia with visible ink and an authentication code, which uniquely corresponds to the value indicia, with invisible ink. However, Wright et al is concerned with printing simple labels and is not concerned with identifying the location of data on a page. Thus Wright et al do not disclose associating the spatial extent of invisible coded data with the spatial extent of visible graphic data. Nevertheless, the Examiner asserts that combining Wright et al with Cooperman et al teaches the limitations of claim 1. Such a combination however fails to teach the present invention for several reasons.

First, it is improper to combine references where the references teach away from their combination. See *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). As described above, Cooperman et al explicitly teach away from a simultaneous association of coded data and graphic data as defined in the present claims. Therefore, the

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possibility that Wright et al. disclose a printer that could be used to print both coded data and graphic data does not mean that a combination of Wright et al and Cooperman et al teaches the present invention.

Second, a teaching or suggestion to make a claimed combination, including a reasonable expectation of success, must be found in the prior art--not in applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Here, the Examiner claims that the motivation to combine Wright et al into Cooperman et al is that it would allow "the printing system to print both visible and invisible data on a paper at the same time." But the advantages of printing visible and invisible data at the same time, so as to associate the spatial extent of the visible data with the spatial extent of the invisible data, are disclosed only in the applicant's disclosure and not in the prior art. Thus there is no teaching, suggestion or motivation to combine Wright et al into Cooperman et al; and, further, even if such a combination is made, the result does not produce the presently claimed invention.

The Applicants submit that the remaining rejections of claims under 35 USC 103(a) are now moot in light of the arguments above.

Therefore it is submitted that the application is now in condition for allowance and the present final rejection should be withdrawn. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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